

### **REMARKS/ARGUMENTS**

By the present amendments and remarks, Applicant respectfully submits that that the rejections have been overcome, and respectfully requests reconsideration of the June 28, 2007 Office Action and allowance of the present application at the Examiner's earliest convenience.

#### **Summary of the Official Office Action**

Claims 17-23 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claim 14 was rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyanagi (US 2002/0044300, hereinafter Oyanagi) in view of Ueda (6,407,822, hereinafter Ueda).

For the reasons set forth below, Applicant submits that each of the pending claims is allowable over the cited art, and an indication of allowability of the present application is therefore respectfully requested.

#### **Traversal of Rejection under 35 U.S.C. § 101**

Claims 17-23 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action submits that "A printing control

program does not explicitly identify a physical thing. Programs are neither computer components nor statutory processes, as they are not acts being performed” (Office Action, page 2). In lieu of the present amendment, Applicant submits that the rejection of claims 17-23 is now moot. As such, Applicant respectfully requests the Examiner withdraw the rejection and indicate claims 17-23 as allowable at the Examiner’s earliest convenience.

**Traversal of Rejection under 35 U.S.C. § 112**

Applicant respectfully traverses the rejection of claim 14 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lieu of the present amendment, Applicant has canceled claim 14 without prejudice and reserves the right to present it at a later time. Accordingly, the rejection of claim14 is moot and Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claim 14 under 35 U.S.C. § 112.

**Traversal of Rejection under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Oyanagi in view of Ueda. In regard to independent claim 1, the Office action has not provided a prior art reference or references that is seen to discuss or describe **all** the claim limitations of the pending claims.

Let us hypothetically assume that the combination of the Oyanagi and Ueda references is proper (which the Applicant disputes). Applicant respectfully submits that the combination still does not disclose or describe any embodiment of a control step where a transmission method is determined as a predetermined method by a first determination step and paper is determined as predetermined paper by a second determination step, and **an output step and a conversion step are performed in parallel** as recited in Independent claim 1.

As amended, independent claim 1 recites, *inter alia*, . . . “a control step of **performing the output step and the conversion step in parallel** when the transmission method is determined as the predetermined transmission method by the first determination step and the paper is determined as the predetermined paper by the second determination step, and of converting one page of data into the print data after the output of the one page of the data by the output step when the transmission method is not determined as the predetermined transmission method by the first determination step or the paper is not determined as the predetermined paper by the second determination step.”

Oyanagi is seen to disclose a multi-function printer with reduced printing time for a copy print (page 1, paragraph 48). Specifically, the printing speed is increased in the multi-function printer by executing a printing operation for scan data scanned by a scanner by using a print image data with a different data arrangement (page 1, paragraph 13). Nothing in Oyanagi is seen to disclose or describe a control step where a transmission method is determined as a predetermined method by a first determination step and paper is determined as

predetermined paper by a second determination step, and an output step and a conversion step are performed in parallel as recited in Independent Claim 1.

Furthermore, Ueda is seen to disclose an image-output apparatus with a copy mode operation for printing image data read by an image reader where the copy mode operation is **mutually synchronized** with a print mode operation (abstract). More specifically, there is a simultaneous execution of a printing operation by banding and of an image input operation by a scanner (column 1, line 60-column 2, line 14). Ueda provides no teaching or suggestion of **switching between the processes and executing the processes in parallel** as recited in Independent Claim 1. Rather, the Applicant notes that Ueda actually teaches away from the above-mentioned concept and instead is seen to disclose that a copy mode operation is **mutually synchronized** with a print mode operation (column 2, lines 9-11).

Because the combined teachings of Oyanagi and Ueda fail to disclose at least the above-noted features of the present invention, Applicant submits that Oyanagi and Ueda alone or, in any combination, fails to disclose each and every feature recited in amended claim 1, and the Office Action has failed to establish an adequate evidentiary basis to support a rejection under 35 U.S.C. § 103.

Moreover, in lieu of the present amendment, Applicant has canceled claims 3, 7, 12, 14, 19, and 21 without prejudice and reserves the right to present them at a later time. Accordingly, the rejection of claims 3, 7, 12, 14, 19, and 21 are moot and Applicant respectfully requests reconsideration and withdrawal of

the outstanding rejection of claims 1 claims 3, 7, 12, 14, 19, and 21 under 35 U.S.C. § 103.

Independent claim 10 is directed to an information processing apparatus and independent claim 17 is directed to a computer-executable program stored on a computer-readable medium. Claims 10 and 17 were rejected for essentially the same reasons as claim 1. As such, the arguments set forth above with respect to claim 1 are applicable to claims 10 and 17.

Claims 2, 4-6, 8-9, 11, 13, 15-16, 18, 20, and 22-23 depend from at least one of allowable base claims 1, 10, or 17. As such, Applicant submits that these claims are allowable at least for the reason that each of these claims depend from allowable base claims 1, 10, or 17 and recite additional features that further define the present invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection of claims 1-23 under 35 U.S.C. § 103.

Furthermore, Applicant asserts that newly added claims 25 and 26 are allowable at least for the reason that they depend from allowable base claim 17 and recite additional features that further define the present invention.

**CONCLUSION**

Applicant respectfully submits that all of the claims pending in the application meet the requirements for patentability and respectfully requests that the Examiner indicate allowance of such claims at the Examiner's earliest convenience.

Any amendments to the claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

In addition, please deduct or credit any underpayment or overpayment of fees associated with submission of this response to Deposit Account Number **502456**.

Should the Examiner have any questions, the Examiner may contact the Applicant's undersigned representative at the (949) 932-3329.

Respectfully submitted,

9/28/07

/Sivon Kalminov/

Date

Sivon Kalminov, Reg. No. 40,042  
Attorney for Applicant

Canon U.S.A. Inc., Intellectual Property Division  
15975 Alton Parkway  
Irvine, CA 92618-3731  
Fax: (949) 932-3560